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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,237	06/15/2001	William George Bickel		7545

7590 09/04/2003  
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EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/04/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/881,237

Applicant(s)

BICKEL ET AL.

Examiner

Nini F. Legesse

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Applicant's request for Continued Examination is acknowledged in paper no. 11.

Applicant's amendment to the specification and the claims is acknowledged in paper no. 12.

### ***Claim Rejections -35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rainey (US Patent No. 5,634,856) in view of Turner (US Patent No. 5,575,473).

Rainey discloses a lightweight practice bat (column 1, line 6 indicates that it can be

used in baseball) comprising:

- A hollow open-ended outer tube of uniform inner and outer diameter for its full length (23);
- A hollow handle of uniform inner and outer diameter for its full length having an open inner end (46, 48) and a closed outer end (referring to Fig. 2, the handle is considered to be closed at the outer end because plug 32 is provided in the handle);
- A solid plug affixedly attached within an outer end of said hollow outer tube opposite to the handle (28); and
- A hollow sliding inner tube positioned inside and guided solely by said hollow outer tube (in column 3, lines 23-25, it is indicated that the striking member 30 **may be** a bearing ball element. From this it can be concluded that the sliding element could be any shape including a tube. In addition, in Fig. 3, item 42 is shown as a sliding tube).

Rainey discloses the invention as recited above but fails to explicitly teach the use of an end cap. However Turner is one example that teaches the use of end caps on sporting devices (for example refer to item 23 on Fig. 5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an end cap as taught by Turner in the Rainey device in order to promote safety by covering sharp edges of devices.

**Claims 3, 5- 9, and 11-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Piazza (US Patent No. 3,578,801).

Rainey in view of Turner fails to explicitly teach the hollow tube, the inner tube, the plug, and the end cap to be made of plastic. However, Piazza discloses a bat wherein the outer hollow tube is made of plastic (column 1, line 55) and wherein the sliding inner tube is made of plastic (column 1, line states that the sliding element is plastic). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide plastic elements as taught by Piazza in the Rainey device in order to provide a device that is simple, easily and inexpensively manufactured.

With respect to the plug to be made of plastic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plastic plug, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

**Claims 4 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Tyner (US Patent No. 6,254,498)

Rainey in view of Turner fails to explicitly include a handle that is made of foam rubber. However, Tyner discloses a handle that is made of a foam rubber (column 4, lines 20-21). Thus, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to provide a handle that is made of a foam rubber as taught by Tyner in the Rainey's device in order to provide a bat that absorbs shock without discomfort to the batter as stated on column 4, lines 25-26 of the Tyner's invention.

***Response to Arguments***

Applicant's arguments with respect to claims 2-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9301.

NFL  
09/01/03



Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700